

In re Application of: ELDAR-FINKELMAN  
Serial No.: 10/538,171  
Filed: December 8, 2005  
Office Action Mailing Date: February 8, 2008

Examiner: Russel, Jeffrey E.  
Group Art Unit: 1654  
Attorney Docket: 29724

### **REMARKS**

Reconsideration of the above-identified application in view of the amendments above and the remarks following is respectfully requested.

Claims 1, 2, 7, 8, 10, 11, 14-17, 24-26, 28, 46-49, 63-65, 67, 71-74, 88-90, 93-99, 101, 118-125, 127-129, 131-135, 141-146, 148-150, 152-156, 162, 163 and 179-186 are in this Application. Claims 1, 2, 7, 8, 10, 11, 14, 15, 24-26, 28, 46-49, 63-65, 67, 71-74, 88, 89, 97-99, 101, 163 and 179-186 have been examined on the merits, with a method of treating non-insulin dependent diabetes mellitus as the elected species. Claims 90, 93-96, 118-125, 127-129, 131-135, 141-146, 148-150, 152-156 and 162 have been withdrawn from consideration as being drawn to non-elected species.

Claims 1, 2, 7, 8, 10, 11, 15-17, 46-49, 63-65, 67, 71-74, 88, 89, 97-99, 101, 163 and 179-185 have been rejected under 35 U.S.C. § 102. Claims 3-6, 9, 12, 13, 18-23, 27, 29-45, 50-62, 66, 68-70, 75-87, 91, 92, 100, 102-117, 126, 130, 136-140, 147, 151, 157-161, 164-166 and 167-178 have been canceled in a previous response.

Claims 1, 2, 7, 8, 10, 11, 46-49, 63-65, 67, 71-74, 88-90, 93-99, 101, 118-125, 127-129, 131-135, 141-146, 148-150, 152-156, 162, 163 and 179-185 have been canceled herewith. Claims 14, 15, 24 and 186 have been amended herewith.

A telephone Interview with the Examiner was conducted on April 14, 2008. In the Interview, Applicant has pointed out to the Examiner that a marked-up copy of the substitute specification, which was submitted in response to the previous Official Action dated August 20, 2007 in order to overcome the Examiner's objection to the disclosure, appears in the Image File Wrapper of the instant application. Applicant has further noted that a Declaration under 37 CFR 1.132, signed by the present inventor, which was submitted in response to the previous Official Action dated August 20, 2007 in order to overcome the Examiner's rejections over the Plotkin et al. article, appears in the Image File Wrapper of the instant application. Applicant wishes to thank the Examiner for his kind attention to these issues during the above-mentioned Interview.

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Subsequent to the Interview, the Examiner has issued an Interview Summary, in which the Examiner has stated that (i) the substitute specification filed December 14, 2007 is now entered; (ii) the prior art rejections based upon the Plotkin et al. article are withdrawn; (iii) claims 14, 24-26, 28 and 186 would be allowable if rewritten in independent form; and (iv) the proposed amendment by the Applicant are supported by the disclosure and would overcome the prior art rejections in the Final Office Action, but will not be entered because they would necessitate further search and consideration.

The following concerns the objections/rejections raised by the Examiner in the outstanding Final Office Action, in view of the above-mentioned Interview Summary.

#### **Amendments To The Specification**

The Examiner has objected in the Final Office Action to the disclosure because of the informality on pages 7, 14, 15 and 23 wherein the words "Deleted: X" appear on the side of the page.

The Examiner has stated therein that the substitute specification filed December 14, 2007 has not been entered because a marked-up copy of the substitute specification has not been supplied.

The Examiner has subsequently stated in the Interview Summary mailed April 17, 2008, that the marked-up copy of the specification has been located in the Image File Wrapper, and that accordingly, the substitute specification filed December 14, 2007 is now entered.

Applicant therefore believes that the Examiner's objection to the disclosure is withdrawn.

#### **Priority**

The Examiner has stated in the Final Office Action that claims 1, 2, 7, 8, 10, 11, 14-17, 24-26, 28, 46-49, 63-65, 67, 71-74, 88, 89, 97-99, 101, 163 and 179-186 are not deemed to be entitled under 35 U.S.C. 119(e) to the benefit of priority of the filing date of

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provisional applications 60/432,644 and 60/482,719, and that accordingly, the Plotkin et al. article is available as prior art against the instant claims.

Claims 1, 2, 7, 8, 10, 11, 46-49, 63-65, 67, 71-74, 88, 89, 97-99, 163 and 179-185 have been canceled. Claims 14, 15, 24-26, 28 and 186 have been amended.

Applicant maintains that the abovementioned claims are entitled to the benefit of the filing date of the abovementioned provisional applications.

Notwithstanding the above, Applicant has chosen, in order to expedite prosecution, to amend the claims so as to read on a peptide conjugate having SEQ ID NO:16 (claim 14). This conjugate is specifically described in the abovementioned provisional patent applications and hence it is clear that the claimed invention, at least with regard to claim 14, is entitled under 35 U.S.C. 119(e) to the benefit of priority of the filing date of provisional applications 60/432,644 and 60/482,719.

#### **Amendments To The Claims**

##### ***35 U.S.C. § 102(a) and 103(a) Rejections – Plotkin et al.***

The Examiner has rejected claims 1, 2, 7, 8, 10, 11, 14, 15, 46-49, 63-65, 71-74, 88 and 89 under 35 U.S.C. 102(a) as being anticipated by Plotkin et al. The Examiner has further rejected claims 16, 17 and 163 under 35 U.S.C. 103(a) as being unpatentable over Plotkin et al. The Examiner has further rejected claims 24-26, 28, 63-65, 67, 97-99 and 101 under 35 U.S.C. 103(a) as being unpatentable over Plotkin et al. in view of the American Diabetes Association article or WO Patent Application 01/49709 (hereinafter WO 01/49709).

In the Interview Summary mailed April 17, 2008, the Examiner has stated that the Rule 1.132 declaration has been located in the Image File Wrapper, and that accordingly, the prior art rejections based upon the Plotkin et al. article are withdrawn.

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***35 U.S.C. § 102(b) Rejections – WO 01/49709***

The Examiner has rejected claims 46-49, 63-65, 67, 71-74, 88, 89, 97-99, 101 and 163 under 35 U.S.C. 102(b) as being anticipated by WO Patent Application 01/49709.

Claims 46-49, 63-65, 67, 71-74, 88, 89, 97-99, 101 have been canceled herewith, thereby rendering moot the Examiner's rejection.

***35 U.S.C. § 102(b) Rejection – Taniguchi et al.***

The Examiner has rejected claims 1, 2, 7, 8, 10, 11 and 179-182 under 35 U.S.C. 102(b) as being anticipated by Taniguchi et al.

Claims 1, 2, 7, 8, 10, 11 and 179-182 have been canceled herewith, thereby rendering moot the Examiner's rejection.

***35 U.S.C. § 102(b) Rejection – Manenti et al.***

The Examiner has rejected claims 1, 2, 7, 8, 10, 11, 15-17 and 179-185 under 35 U.S.C. 102(b) as being anticipated by Manenti et al. in view of Taniguchi et al.

Claims 1, 2, 7, 8, 10, 11 and 179-185 have been canceled herewith, thereby rendering moot the Examiner's rejection with respect thereto. Claim 15 has been amended.

Specifically, claim 15 has been amended so as depend from claim 14. Claim 14 recites a peptide conjugate having SEQ ID NO:16. Claims 16 and 17 depend from claim 15.

Since neither Manenti et al. nor Taniguchi et al. teaches the claimed conjugate, let alone a pharmaceutical composition containing same, Applicant strongly believes that claims 15-17 are allowable.

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### *Claim Objections*

In the Interview Summary mailed April 17, 2008, the Examiner has stated that claims 14, 24-26, 28 and 186 are objected to as being in dependent form, but would be allowable if rewritten in independent form.

Claims 14, 24 and 186 have been amended so as to be in independent form. Claims 25, 26 and 28 depend from claim 24.

Claim 15 has been amended so as to depend from claim 14. Claims 16 and 17 depend from claim 15. Although not mentioned in the Examiner's statement with regard to objected claims, Applicant strongly believes that since claim 14, which reads on a peptide conjugate having SEQ ID NO:16, is allowable, amended claim 15, which reads on a pharmaceutical composition comprising this peptide conjugate and a carrier, is also allowable.

Applicant therefore believes that amended claims 14 and 15, claims 16 and 17, amended claim 24, claims 25, 26 and 28 and amended claim 186 are allowable.

In view of the above amendments and remarks it is respectfully submitted that amended claims 14 and 15, claims 16 and 17, amended claim 24, claims 25, 26 and 28, and amended claim 186 are now in condition for allowance. A prompt notice of allowance is respectfully and earnestly solicited.

Respectfully submitted,



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Date: May 29, 2008

Enclosed:  
Petition for Extension (1 Month).